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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,005	03/08/2001	Christopher Keith	IVEN125474	7701
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CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			FELTEN, DANIEL S	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/802,005

Applicant(s)

KEITH, CHRISTOPHER

Examiner

Daniel S. Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/17/2001.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on September 07, 2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

2. Claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*See claims 12-15*, The examiner is not clear as to what the applicant means by “reporting”. Isn’t this merely an electronic transmission of data to a user or is “reporting” referring to a document?

*See claims 16-25*, The examiner is unclear what the applicant means by negotiation “form”. Is the applicant claiming an electronic or physical application to be filled out by the user, or does negotiation “form” mean a sheet or questionnaire or a kin of negotiation?

*See claims 29-36*, the examiner is unclear as to what the applicant means by “order”? Does the applicant mean a command in terms of bidding for an item or does the applicant mean a purchase of an item (*e.g.*, a requisition) (where the former is more of a directive and the later is a reservation)?

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 3-6, 10-15 and 29-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverman et al (US 5,924, 082)

***As in claim 1***, A method of facilitating trading, comprising:

automatically discovering that a contra-party trading process is interested in trading an item,(see Silverman, Abstract, fig. 2, Ref. No. 201, 201; col. 7, ll. 14-33)

automatically sending a trading proposal (*bid or offer*) to a market process for forwarding to the contra-party trading process (see Silverman, fig. 2, Ref. No. 203; col. 7, ll. 14-33).

*As in claim 3*, comprising sending an inquiry to the market process to discover whether there is a contra-party trading process interested in trading the item (see Silverman, col. 7, ll. 14-33).

*As in claim 4*, wherein the trading proposal specifies a choice of negotiation methodology (see Silverman, col. 7, ll. 25-30).

*As in claim 5*, wherein the negotiation methodology is selected from personal negotiation, direct negotiation via a computer system, and brokered negotiation (see Silverman, col. 7, ll. 25-30)

*As in claim 6*, wherein the market process checks the disclosure level of the contra-party trading process before forwarding the trading proposal (see Silverman, col. 4, ll. 13-27)

*As in claim 10*, A method of facilitating trading, comprising:  
automatically receiving a price proposal (*bid*) for an item from a first trading process (see Silverman, col. 7, ll. 14-33), and

automatically forwarding the price proposal (*bid*) to a second trading process (see Silverman, col. 8, ll. 11-16), wherein

contra-party lists associated with the first and second trading processes have been compared (*via filtering*), and disclosure compatibility of the first and second trading processes has been checked (see Silverman, col. 8, ll. 20+).

*As in claim 11*, wherein the automatically receiving and forwarding are performed by a market process (see Silverman, col. 7, ll. 14-33)

*As in claim 12*, Silverman discloses a method of facilitating trading, comprising:

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automatically comparing contra-party lists (*input data*) associated with an active negotiation request and a passive negotiation request (see Silverman, col. 7, ll. 25-30)

automatically checking the compatibility of fields of the active and passive negotiation requests (see Silverman, col. 7, ll. 25-30), and

automatically reporting to the owners of the active and passive negotiation requests (see Silverman, Abstract, see also *signaling or displaying*, col. 7, ll. 55-63; and col. 8, 11+).

**As in claim 13**, the fields are incompatible and the automatically reporting reports an inquiry (see Silverman, Abstract, see also *signaling or displaying*, col. 7, ll. 55-63; and col. 8, 11+).

**As in claim 14**, wherein the fields are compatible and the automatically reporting reports a pairing (*or matching*) (see Silverman, Abstract, see also *signaling or displaying*, col. 7, ll. 55-63; and col. 8, 11+)

**As in claim 15**, wherein the automatically comparing and checking are performed by a market process (see Silverman, Abstract, see also *signaling or displaying*, col. 7, ll. 55-63; and col. 8, 11+)

**Re claim 29**, a method of facilitating trading, comprising:

automatically storing an order (*bid or offer*) in association with a disclosure parameter (see Silverman, col. 7, ll. 31-42), an

automatically responding to a price inquiry (*bid or offer*) in accordance with the disclosure parameter (see Silverman col. 7, ll. 37+).

**Re claim 30**, further comprising notifying an owner of the stored order of the price inquiry(see Silverman col. 7, ll. 31-42) .

**Re claim 31**, wherein each of the stored order and price inquiry is associated with a respective call list (*filtering*), and wherein automatically responding includes automatically checking for compatibility of call lists (see Silverman, col. 12, ll. 47-58).

**Re claim 32**, wherein each of the stored order and price inquiry is responding includes associated with a respective disclosure policy, and wherein automatically checking for compatibility of disclosure policies (see Silverman, col. 7, ll. 37+).

**Re claim 33**, wherein each of the disclosure policies specifies a disclosure level selected from (i) none, (ii) owner, (iii) owner an symbol, (iv) owner, symbol side, (v) owner, symbol, side, and approximate minimum lot size, (vi) owner, symbol, side, lot size and hard price. minimum lot size and soft price, and (vii) owner, symbol, side (see Silverman, fig. 4/4A, col. 10, ll. 59+).

**Re claim 34**, wherein the response is text message (*freestyle dialog-410/400*) (see Silverman, col. 12, ll. 47-58)

**Re claim 35**, wherein the response includes a soft price (see Silverman, col. 2, ll. 17-30; and col. 12, ll. 18-36).

**Re claim 36**, wherein the automatically responding is based on a relationship (*negotiations*) with at least one of the owner of the order and the owner of the price inquiry (see Silverman (see Silverman, col. 12, ll. 59+).

***Re claim 37***, A method of facilitating trading, comprising;  
automatically receiving a price inquiry (*bid*) from a party associated with a disclosure parameter (see Silverman, col. 11, ll. 63 to col. 12, ll. 5), and  
automatically responding to the price inquiry in accordance with the disclosure automatic parameter (see Silverman, col. 11, ll. 63 to col. 12, ll. 5).

***Re claim 38***, A method of facilitating trading, comprising:  
automatically receiving a discovery request for a negotiation (see Silverman, col. 4, ll. 28-40,  
automatically determining that a trade is not possible by comparing counter-party lists associated with the discovery request and with a file of negotiation requests (see Silverman, col. 4, ll. 12-27), and  
automatically adding the discovery request to the file of negotiation requests (see Silverman, col. 4, ll. 28-40).

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5. Claims 16-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Buist (US 6,408,282)

***Re claim 16***, A method of facilitating trading, comprising:

receiving a choice of negotiation form (*or screen*) (see Buist, figs. 42 & 43; col. 29, ll. 12-20),

automatically detecting a trading opportunity according to the chosen negotiation form (see Buist, col. 29, ll. 20-23), and

automatically notifying a party of a trading opportunity using the chosen negotiation form (see Buist, col. 29, ll. 17 to col. 30, ll. 60).

***Re claim 17***, wherein automatically detecting includes checking a discretion level of the party (see Buist, col. 29, ll. 17 to col. 30, ll. 60)

***Re claim 18***, wherein automatically detecting includes checking a preference rating of the party (see Buist, col. 29, ll. 17 to col. 30, ll. 60)

***Re claim 19***, wherein the choice of negotiation form is specified during system set-up (see Buist, col. 29, ll. 17 to col. 30, ll. 60)

***Re claim 20***, wherein the choice of negotiation form is specified during each trading opportunity (see Buist, col. 29, ll. 17 to col. 30, ll. 60),

**Re claim 21**, wherein the negotiation form is selected from at least two of inquiry negotiation, direct negotiation via a computer system, and brokered negotiation (see Buist, col. 29, ll. 17 to col. 30, ll. 60)

**Re claim 22**, wherein inquiry negotiation form and the notice of the trading opportunity includes a text message (see Buist, col. 29, ll. 17 to col. 30, ll. 60)

**Re claim 23**, wherein direct negotiation is the chosen negotiation form and the computer system is operative to transmit messages between the negotiating parties (see Buist, col. 29, ll. 17 to col. 30, ll. 60)

**Re claim 24**, wherein brokered negotiation is the chosen negotiation form and the notice of the trading opportunity identifies the broker (see Buist, col. 29, ll. 17 to col. 30, ll. 60)

**Re claim 25**, wherein the broker is a market process (see Buist, col. 29, ll. 17 to col. 30, ll. 60)

**Re claim 26**, A method of facilitating trading, comprising:  
automatically detecting that a reserve price of a passive side order is at least the reserve price of an active side order, and passive side orders that automatically advising the owner of at least one of the active a trade is possible (see Buist, col. 29, ll. 17 to col. 30, ll. 60).

**Re claim 27**, further comprising comparing disclosure parameters to determine whether the trade is possible (see Buist, col. 29, ll. 17 to col. 30, ll. 60)

**Re claim 28**, further comprising comparing contra-party lists to determine whether the trade is possible (see Buist, col. 29, ll. 17 to col. 30, ll. 60)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (US 5,924,082) in view of Davis, II (US 3,702,007) and Schieltz (US 4,456,957)

***Re claim 2***, Silverman discloses automatically generating the trading one condition and at least proposal having rules where each rule has at least one action to be taken when the condition is satisfied (see Silverman col. 7, ll. 37-42), but fails to disclose using a *decision table* (per se) having rules, each rule having at least one action to be taken when the condition is satisfied. In the prior art, a decision table is a tabular listing of possible conditions (inputs) and the desire (result) output corresponding to each conditions. A decision table may be used in the preliminary analysis of program flow, or it may be converted or incorporated into the program itself.

Davis discloses a driver that executes a decision table having a set of rules-13, a condition stub-12, and an action stub-14 which perform a series of instructions based upon inputs to the table (see Davis, col. 2, ll. 21-50).

Schieltz shows a decision table-61 further being employed to effect the way data is routed in a network of remote terminals (see Schieltz, Abstract, col. 13, ll. 23-50).

Since Silverman includes a matching computer that is coupled to remote terminals and uses decision processes to compare and match input from counterparties to make transactions, as well as transmit negotiation messages (see Silverman, col. 5, ll. 22-67), it would have been obvious for an artisan at the time of the invention to recognize the fact that the matching process is an art recognize equivalent to the decision table of Davis and Schieltz in so much as the input filtering functions are basically rules which the system uses against the input data to match the various criteria and perform the action of the transaction. Thus it would have been obvious to integrate the decision table as taught by Davis and Schieltz into Silverman to automatically match users making offers or bids with potential counterparties who are interested in the type of bid/offer being made by the offeror/bidder, as enunciated by Silverman (see Silverman col. 4, ll. 4+). Thus such a modification would have been within the ordinary skill of the art.

***Re claim 7***, a method of facilitating trading, comprising:

receiving a trading proposal for a posted item (see Silverman, col. 4, ll. 4-12),  
automatically determining how to respond in accordance with an order processing methodology represented in a *decision table* having rules, each rule having at least one condition and at least one action to be taken when the condition is satisfied, and automatically responding in accordance with the order progressing methodology (see discussion related to a *decision table* above in claim 2).

***Re claim 8***, wherein the posted item posted at a market, and the trading proposal is received from the market (see Silverman, col. 7, ll. 14-33).

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***Re claim 9***, wherein the market received the trading proposal from a contra-party trading process (see Silverman, col. 7, ll. 14-33).

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Micali (US 5,615,269) discloses an ideal electronic negotiations

Leiseca et al (US 5,253,165) discloses computerized reservations and scheduling system

Luke et al (US 6,131,087) discloses a method for automatically identifying, matching and nearly matching buyers and sellers in electronic market transactions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742.

The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF  
February 01, 2006

Daniel S Felten  
Examiner  
Art Unit 3624